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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/669,829
Filing Date: September 24, 2003
Appellant(s): STANSBURY, MARK A.

J. Stephen Wills
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 10, 2009 appealing from the Office action mailed July 8, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct¹.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

NEW GROUND(S) OF REJECTION

Claim 45 has been added to the rejection under 35 U.S.C. 103(a) as being unpatentable over Brabson in view of Born; claims 48 and 50 have been added to the rejection under 35 U.S.C. 103(a) as being unpatentable over Brabson in view of Benton

¹ Claim 48 was amended in the claim listing 12/14/2007 without markings or a status identifier. It appears that the amendment to the claim was inadvertent and the claim language omitted from the claim listing of May 15, 2007 should be included for completeness. The examiner has interpreted claim 48 to read as follows: The mount of claim 46, wherein the mount is adapted to be coupled to the furnace free of any mechanical fastener connecting with said main body member. (Emphasis added)

and in further view of Born; and claims 29 and 52 have been added to the rejection under 35 U.S.C. 103(a) as being unpatentable over Griswold in view of Brabson and Benton and in further view of Born. Each of claims 29, 45, 48, 50 and 52 requires the mount to be coupled (or adapted to be coupled) to the furnace free of "any mechanical fasteners" or "free of engagement with any mechanical fasteners." The examiner maintains that each of these claims should have been included with the claim from which it depends since the combination of Brabson and Born make obvious the adherent component including an adhesive surface adapted to engage and couple the main body member with a furnace. The adhesive surface is considered "free of engagement with any mechanical fasteners" is the same manner as appellant's adhesive material 17 (specification, page 7, Figure 4). Each effected grounds of rejection set forth below has each been modified and each modification to the rejection set off in *italics* to be consistent with this new grounds of rejection.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 29, 45, 48, 50, and 52 under 35 U.S.C. 112 1st paragraph.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1,647,828	GRISWOLD	11-1927
1,880,153	ROSENZWEIG	9-1932

1,887,283	BRABSON	11-1932
3,583,215	FRANZ	7-1971
4,721,275	BENTON ET AL	1-1988

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 5, 8-11, 26, 30, 31, 34, 35, 40, 43, 45, and 56-58 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 1,887,283 to Brabson in view of U.S. Patent 3,326,508 to Born. Brabson discloses a mount (20) capable of supporting a furnace above the floor, the mount comprising: an integrally formed main body member having a first surface adapted to engage the floor and a second surface spaced from the first surface and adapted to support the furnace above the floor, the main body member including a pair of integrally formed upstanding wall members (21) defining a locator portion to abut an outer surface of the furnace and position the furnace relative to the main body member; wherein the upstanding wall members extend substantially along two sides of the main body member; wherein the main body member has a first vertical length and at least one of the upstanding wall members has a second vertical length; and wherein the mount is a rigid body.

Brabson discloses the claimed invention except for the limitation of an adherent component connected with the main body member and located proximate the second surface and a vibration dampening material located on the second surface. Born teaches a mount having a main body member (22), the main body member having a first surface and second surface spaced from the first surface an adherent component

connected with the main body member and located proximate the second surface, the adherent component including an adhesive surface (21A) adapted to engage and couple the main body member with a furnace, wherein the adherent component includes a vibration dampening portion (21) located between the second surface and the adhesive surface, wherein the adhesive surface is substantially parallel with the second surface, wherein the vibration dampening portion includes an elastomeric material, and wherein the main body is free of engagement with any mechanical fasteners. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the mount in Brabson to have included the adherent component and the vibration dampening material as taught by Born for the purpose of improving the grip between the mount and the adapted body, i.e., the furnace and for the purpose of providing a means to level out or balance any height irregularities of the object to be supported and to dampen or absorb vibrations placed on the object from the environment. *Regarding claim 45, the combination of Brabson and Born make obvious the adherent component including an adhesive surface adapted to engage and couple the main body member with a furnace. The adhesive surface is considered "free of engagement with any mechanical fasteners" is the same manner as appellant's adhesive material 17 (specification, page 7, Figure 4).*

Brabson in view of Born disclose the claimed invention except for the limitations of the first vertical length of the main body member being substantially equal to the second vertical length of at least one upstanding wall member, the first vertical length

being greater than the second vertical length, and the mount being of a polymeric material. Note the term "molded" is not afforded any patentable weight because it is a process of making an item as oppose to a structural limitation of the claimed invention. The alterations in the lengths are merely for aesthetics and would have been obvious to one having ordinary skill in the art the time the invention was made since no unpredictable results would have been yielded by the specific dimensions between the vertical lengths of the main body member and the upstanding wall.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the material of the mount Brabson to have been a polymeric material, since such a modification would have merely involved substituting one well known material for another based on the materials suitability for the intended use and would not have yielded any unpredictable results.

Claims 6 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Brabson in view of Born and in further view of U.S. Patent 1,880,153 to Rosenzweig. Brabson discloses the claimed invention except for the limitation of vibration dampening material being defined by a cork material. Rosenzweig teaches a vibration dampening unit comprising a cork material (16) for absorbing or dampening vibrations. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the vibration dampening material in Born to have been a cork material as taught by Rosenzweig for the purpose of providing an alternative mechanically equivalent material for absorbing and dampening vibrations of the mount.

Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Brabson in view of Born and in further view of U.S. Patent 3,583,215 to Franz. Brabson in view of Born disclose the claimed invention except for the limitation of the vibration dampening material being defined by an elastomeric and cork configuration. Franz teaches an apparatus comprising a layer of vibration material (60), wherein the material is formed of a rubber and cork composite (Co. 4, line 14ff). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the vibration dampening material in Born to have included a rubber and cork configuration as taught by Franz for the purpose of providing an alternative, mechanically equivalent material for dampening vibration and since such a modification would have yielded any unpredictable results.

Claims 15, 17-20, 28, 46, 47, 48, 49 and 50 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Brabson in view of U.S. Patent 4,721,275 to Benton et al., hereinafter, Benton, and in further view of Born. Brabson discloses a mount (20) capable of supporting a furnace above the floor, comprising: an integrally formed main body member having a first surface adapted to engage the floor and a second surface spaced from the first surface, the main body member including a pair of integrally formed upstanding wall members (21) defining a locator portion to abut an outer surface of an object; wherein the locating portion includes two upstanding members that are oriented perpendicular to one another; wherein the first and second surfaces are substantially parallel; wherein the upstanding wall members extending substantially

along two sides of the main body member; and wherein the two upstanding wall members have bearing surfaces.

Brabson discloses the claimed invention except for the limitation of a vibration dampening material located on the second surface. Benton teaches a mount having a main body including a first surface and a second surface, a vibration dampening material (34) constructed of cork material (Col. 2, line 7ff) and located on the second surface and a mounting screw (42) for securing the mount to the outer surface of the object (12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the mount in Brabson to have included the vibration dampening material as taught by Benton for the purpose of providing a means for cushioning the mount.

Brabson in view of Benton disclose the claimed invention except for the limitations of the vibration material being elastomeric and an adherent component connected to the main body member and located proximate the second surface, the adherent component including an adhesive surface. Born teaches a mount (Fig. 2) having an integrally formed rigid main body member (22) having a first surface and second surface, a vibration dampening material (21) located on the second surface and is defined by an elastomeric material, an adherent component including an adhesive surface (21A) connected to the main body member and located proximate the second surface, wherein the adhesive surface is spaced from the second surface, the adhesive surface is substantially parallel to the second surface, the vibration dampening component (21) is located between the second surface and the adhesive surface, and

wherein the mount is adapted to be coupled to an object free of any mechanical fasteners. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the mount in Brabson combined with Benton to have included the vibration dampening material and adherent component as taught by Born for the purpose of providing an alternative, mechanically equivalent means for cushioning the mount and for providing an alternative, mechanically equivalent means for fastening the mount to the outer surface of the supported object.

Brabson combined with Benton and Born disclose the claimed invention except for the limitation of the main body member supporting the furnace about at least 2 inches above the floor and the main body of the mount being of a polymeric material. Note the term "molded" is not afforded any patentable weight because it is a process of making an item as oppose to a structural limitation of the claimed invention.

Regarding claims 48 and 50, the combination of Brabson, Benton and Born make obvious the adherent component including an adhesive surface adapted to engage and couple the main body member with a furnace. The adhesive surface is considered "free of engagement with any mechanical fasteners" is the same manner as appellant's adhesive material 17 (specification, page 7, Figure 4).

It would have been obvious to one ordinary skill in the art at the time the invention was made to have modified the thickness of the main body in Brabson to have been of a dimension to have the supported object 2 inches from the floor since such a modification merely involves a change in size and since there is no criticality provided for this limitation.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the material of the mount Brabson to have been a polymeric material, since such a modification would have merely involved substituting one well known material for another based on the materials suitability for the intended use and would not have yielded any unpredictable results.

Claims 21, 22, 29, 51, 52 and 53 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 1,647,828 to Griswold in view of Brabson and Benton and in further view of Born. Griswold discloses a furnace (5) having a plurality of legs (6) disposed at each corner of the furnace. Griswold discloses the claimed invention except for the limitations of a plurality of mounts each having a rigid main body including first and second surfaces, a vibration dampening component having an outer adhesive surface, and integrally formed locating portions extending up from the second surface to abut an outer surface of the furnace.

Brabson discloses a mount (20) capable of supporting a furnace above the floor, comprising: an integrally formed main body member having a first surface adapted to engage the floor and a second surface spaced from the first surface, and the main body member including a pair of integrally formed upstanding wall members (21) defining a locator portion to abut an outer surface of an object.

Benton teaches a mount having a main body including a first surface and a second surface, a vibration dampening material (34) constructed of cork material (Col. 2, line 7ff) and located on the second surface and a mounting screw (42) for securing the mount to the outer surface of the object (12).

Born teaches a mount (Fig. 2) having an integrally formed rigid main body member (22) having a first surface and second surface, a vibration dampening material (21) located on the second surface and is defined by an elastomeric material, an adherent component including an adhesive surface (21A) connected to the main body member and located proximate the second surface, wherein the adhesive surface is spaced from the second surface, the adhesive surface is substantially parallel to the second surface, the vibration dampening component (21) is located between the second surface and the adhesive surface, and wherein each of the mounts are coupled to an object free of any mechanical fasteners.

It would have been obvious to one having ordinary skill in the art at the time invention was made to have modified the legs of the furnace in Griswold to have been replaced by the mounts as taught by Brabson combined with Benton and Born for the purpose of providing a means for dampening vibration of the furnace. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the material of the mount in Brabson to have been polymeric since such a modification would have merely involved substituting one well known material for another based on the materials suitability for the intended use.

Regarding claims 29 and 52, the combination of Griswold, Brabson and Born make obvious the adherent component including an adhesive surface adapted to engage and couple the main body member with a furnace. The adhesive surface is considered "free of engagement with any mechanical fasteners" is the same manner as appellant's adhesive material 17 (specification, page 7, Figure 4).

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 29, 45, 48, 50, and 52 under 35 U.S.C. 112 1st paragraph.

(10) Response to Argument

In regards to appellant's argument that the criteria for a prima facie case of obviousness has not been established, the examiner disagrees, below are the requirements applied for establishing obvious under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The examiner believes these requirements have been met.

In response to appellant's arguments with respect to the 35 U.S.C. 112 1st paragraph rejection, the rejection of claims 29, 45, 48, 50, and 52 has been withdrawn and a new rejection on the merits of the claims has been applied.

In response to appellant's argument that the combination of the references to Brabson and Born is improper, the examiner disagrees, both references are intended to be used with a leg of a piece of furniture and disclose mounts used to support the leg

above a ground surface. The appellant suggest that the intended use of Brabson's reference would be destroyed by combining the adherent component taught by Born. The applicant merely claims an adherent component including an adhesive surface adapted to couple the main body of the mount to a surface of a furnace, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims, and in this case, the appellant does not specifically state what type of adhesive surface is employed. Born discloses an adhesive surface that is a pressure-sensitive adhesive which may be in the form an adhesive, such as double sided tape, which is reusable and does not permanently attach to a surface, thus, the pressure-sensitive adhesive taught by Born is combinable with the reference to Brabson for the purpose of providing a means to improve the grip between the supported object (furnace) and the support (mount), wherein the supported object may be temporarily adhered to the support.

In response to appellant's argument that affidavits filed on February 11, 2004 supporting commercial success of the products created under the claimed aspects of the present invention are evidence that the Brabson and Born references would not be combined by one of skill in the art, the affidavits in question were addressed in the office action dated March 25, 2004 and where found to be unconvincing. The appellant has not shown a nexus between the claimed features and the commercial success of the invention. Conclusory statements or opinions of increased sales being due to the merits of the invention are insufficient without a showing the commercial success is linked to the claimed invention and not to some extraneous factor. The showing should include

a description of what is sold, sales results encompassing total sales for competing products in the market, indicated difference between these products and the applicant's total sales for products embodying the invention and pricing of various products. Gross sales figures do not show commercial success absent evidence as to market share.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR

41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Anita M. King/
Primary Examiner, Art Unit 3632

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Katherine Matecki/
Director, Technology Center 3600

November 30, 2009

Conferees:

/J. ALLEN SHRIVER II/
Supervisory Patent Examiner, Art Unit 3632

Darnell Jayne, APS /dj/